

## **REMARKS/ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application.

In the present office action, the Examiner has failed to indicate whether reference WO 01/87797 on form PTO 1449 submitted on June 27, 2003 by Applicants was considered as required. *See* MANUAL OF PATENT EXAMINING PROCEDURE § 609III.C (2004). Applicants submit that the Information Disclosure statement was filed in compliance with the content requirements of 37 CFR 1.98, and in accordance with the procedural requirements of 37 CFR 1.97. Accordingly, Applicants request consideration of this reference, and ask that the Examiner initial this reference indicating that the reference was considered.

### **II. Disposition of the Claims**

Claims 1-56 are pending in this application; claims 1-17, 19, 20, 22, 24-40, 42, 43 and 45 are rejected; claims 18, 21, 23, 41, 44 and 46 are objected to; and claims 1-56 are subject to restriction and/or election requirement. In this response, claims 1, 4, 5, 9, 17, 19, 24, 27, 28, 32, 42 and 47 have been amended herein. Claims 15, 16, 38, 39 and 48-56 have been cancelled. All amendments are made in a good faith effort to advance the prosecution on the merits of this case. Applicants reserve their rights to subsequently take up prosecution on the claims as originally filed in this or an appropriate continuing application. Applicants respectfully request that these amendments above be entered and submit that these amendments will put the claims in condition for allowance. Antecedent basis for these amendments can be found throughout the specification.

### **III. Remarks Regarding Election/Restriction Requirement**

In the present office action the Examiner has stated that “[c]laim 47 is generic to a plurality of disclosed patentably distinct species comprising a screen and a perforated shroud. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.”

Accordingly, Applicants hereby confirm the election of the screen species and have amended claim 47 and cancelled claims 48-56 directed to a method including a perforated shroud. Applicants reserve the right to pursue these claims as filed in a divisional or other continuing application.

#### **IV. Rejections of the Claims Under 35 U.S.C. § 112**

##### **A. Rejection of Claims 4, 5, 9, 16, 27, 28, 39 and 42**

Claims 4, 5, 9, 16, 17, 19, 27, 28, 39 and 42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. (Office Action, at page 2). Although Applicants believe that this language was sufficiently definite to meet the requirements of 35 U.S.C. § 112, Applicants have amended the Markush grouping language in these claims per the Examiner's suggestion. Because the original language was sufficiently definite, there is no change in claim scope because of these amendments. Applicants respectfully request that these amendments be entered and submit that these amendments will put these claims in condition for allowance.

##### **B. Rejection of Claims 17 and 19**

Claims 17 and 19 are deemed insufficient antecedent basis for this limitation in the claim. (Office Action, at page 3). Applicants have amended the language in these claims per the Examiner's suggestion. Applicants respectfully request that these amendments be entered.

#### **V. Rejection of Claims Under 35 U.S.C. § 102(b)**

##### **A. Rejection of Claims 1-10, 15, 16, 20, 22, 24-33, 38, 39, 43, 45 and 47**

Claims 1-10, 15, 16, 20, 22, 24-33, 38, 39, 43, 45 and 60 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,390,195 to Nguyen, et al. (hereinafter "Nguyen"). With respect to these claims and Nguyen, the Examiner states that:

Nguyen discloses a method of controlling the production of particulates from a well by emplacement of a permeable cement within the well bore penetrating a subterranean formation. The permeable cementing slurry is positioned in the annulus between a perforated pipe and the open wellbore. In one embodiment, Nguyen (Col. 5, ll. 52-61) may employ a screen. Nguyen further provides the cement with a particulate cross-linked gel containing an internal breaker which causes the gel to break "whereby vugs and channels are formed in the set cement column" (Col. 2, ll. 42-51; col. 3, l. 33).

(Office Action, at page 3). With respect to claims 1 and 24 the Examiner states that "[i]nsofar as one of the breakers may comprise the enzyme hemicellulase, it is deemed that the particulate cross-linked gel inherently comprises 'a degradable material capable of undergoing an irreversible degradation downhole'...by virtue of the enzyme attack or cleavage of the

hydratable polymer component, such as hydroxyalkylcellulose, of the particulate cross-linked gel.” (Office Action, at page 3-4).

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). Nguyen does not disclose every element as recited in Applicants’ claims 1 and 24. Therefore, Nguyen cannot, as a matter of law, anticipate Applicants’ claims.

In particular, independent claims 1 and 24 recite “a degradable material that comprises a degradable polymer chosen from the group consisting of polysaccharides, chitins, chitosans, proteins, aliphatic polyesters, poly(lactides), poly(glycolides), poly(ε-caprolactones), poly(hydroxybutyrates), polyanhydrides, aliphatic polycarbonates, poly(orthoesters), poly(amino acids); poly(ethylene oxides), or polyphosphazenes; and/or a dehydrated salt.” Nguyen does not teach the recited degradable polymers, nor does it teach the use of a dehydrated salt. In contrast, Nguyen concerns “a hydratable polymer of hydroxyalkylcellulose grafted with vinyl phosphonic acid.” (Nguyen, col. 3, ll. 11-12).

Therefore, Nguyen does not disclose all elements of claims 1 and 24, and thus these claims are allowable over Nguyen. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2-10, 15, 16, 20, 22, and 25-33, 38, 39, 43, 45 and 47 depend from claim 1 and claim 24, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully request the withdrawal of these rejections.

## **VI. Rejection of Claims Under 35 U.S.C. § 103(a)**

The rejections set following quotation of the appropriate paragraphs of 35 U.S.C. § 103(a) which forms the basis for all obviousness forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**A. Rejection of Claims 11-14 and 34-37**

Claims 11-14 and 34-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nguyen (U.S. Patent No. 6,390,195) and further in view of Metcalf (U.S. Patent No. 4,210,455). With respect to these claims, the Examiner states that “Metcalf discloses the use of a fluid loss agent in well cement slurries.” (Col. 1, ll. 36-59) (Office Action at p. 5). Additionally, the Examiner states that “Metcalf further discloses that their cement composition is mixed ‘on-the-fly.’” (Col. 2, ll. 22-33) (Office Action at p. 5).

To form a basis for a §103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). However, as discussed in IV.A above, Nguyen does not teach or suggest “a degradable material that comprises a degradable polymer chosen from the group consisting of polysaccharides, chitins, chitosans, proteins, aliphatic polyesters, poly(lactides), poly(glycolides), poly(ε-caprolactones), poly(hydroxybutyrates), polyanhydrides, aliphatic polycarbonates, poly(orthoesters), poly(amino acids); poly(ethylene oxides), or polyphosphazenes; and/or a dehydrated salt.” Similarly, Metcalf does not teach the use of the types of degradable polymers and/or dehydrated salts recited in Applicants’ claims 1 and 24. Therefore, Applicants assert that claims 11-14 and 34-37 are allowable over the combination of Nguyen and Metcalf, and request the withdrawal of the rejections thereto.

**B. Rejection of Claims 17 and 40**

Claims 17 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nguyen (U.S. Patent No. 6,390,195) and further in view of Vollmer (U.S. Patent No. 2,288,557). With respect to these claims and Nguyen, the Examiner states that

... it would have been obvious to one of ordinary skill in the art to which the invention pertains, to similarly admix a plasticizer with the permeable well cementing slurry comprising a degradable polymer circulated in the well bore cementing process of Nguyen as taught by Vollmer, in order to improve the workability or pumpability of the cementing slurry. (Office Action of p. 6).

To form a basis for a §103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). However, as discussed in IV.A above, Nguyen does not teach or suggest “a degradable material that comprises a degradable polymer chosen from the group consisting of

polysaccharides, chitins, chitosans, proteins, aliphatic polyesters, poly(lactides), poly(glycolides), poly( $\epsilon$ -caprolactones), poly(hydroxybutyrates), polyanhydrides, aliphatic polycarbonates, poly(orthoesters), poly(amino acids); poly(ethylene oxides), or polyphosphazenes; and/or a dehydrated salt.” Furthermore, Vollmer does not teach the use of the types of degradable polymers and/or dehydrated salts recited in Applicants’ claims 1 and 24 either. Therefore, Applicants assert that claims 17 and 40 are allowable over the combination of Nguyen and Vollmer, and request the withdrawal of the rejections thereto.

## **VII. Allowable Subject Matter**

Applicants acknowledge the Examiner’s recognition that claims 19 and 42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, 2d paragraph, set forth in this Office Action and to include all of the limitations of the base claim and in intervening claims.

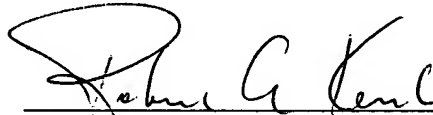
Claims 18, 21, 23, 41, 44 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**SUMMARY**

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record below by telephone, facsimile, or electronic mail at the Examiner's convenience.

We believe that no fees are due with this response; however, the Commissioner is authorized to debit any additional fees to Halliburton Energy Services, Inc.'s Deposit Account No. 08-300, Order No. HES 2003-IP-010077U1 for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Kent", is written over a horizontal line.

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